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10/570,347

06/28/2006

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P29468

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7055 7590 05/14/2009  
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EXAMINER

COLLADO, CYNTHIA FRANCISCA

ART UNIT

PAPER NUMBER

3781

NOTIFICATION DATE

DELIVERY MODE

05/14/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
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|                              |                                       |                                      |  |
|------------------------------|---------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/570,347  | <b>Applicant(s)</b><br>GIRARD ET AL. |  |
|                              | <b>Examiner</b><br>CYNTHIA F. COLLADO | <b>Art Unit</b><br>3781              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant submitted an amendment dated January 23, 2009 wherein claims 1-7 were canceled and 8-24 remain in the application for reconsideration.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/49728 A1 (WO 728).

Regarding claim 8, regarding the cross country ski, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

WO 728 discloses a ski comprising a central zone adapted to receive a device for binding a boot to the ski (fig 3, element 3), the central zone of the ski comprising a binding zone having a location for receiving the binding device and an upper support surface of the ski (figs 5-7), the upper support surface of the ski being arranged on a

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least one of two lateral sides (elevated central area 3 in figs 5-7) of the location to receive the binding device, the upper support surface being capable of coming in direct contact with the boot when a skier using the cross-country ski system exerts a pressure force (fig 6, element 5' and 5''), the location for receiving the binding device comprises an upwardly facing recess of the upper surface of the ski (7,7',7'', page 11, lines 15-16).

Regarding claim 9, WO 728 discloses the central zone of the ski, at least one lateral shoulder arranged on one of the two lateral sides of the location for receiving the binding device such that the boot can be supported directly on the shoulder (fig 6, element 7' and 7'').

Regarding claim 10, WO 728 discloses the ski comprises two lateral upper surfaces arranged on respective lateral sides of the location for receiving the binding device (fig 6, element 7' and 7'').

Regarding claim 11, WO 728 discloses the shoulder comprises a support surface for the boot arranged above the upper surface of the location for receiving the binding device (fig 6, elements 7' and 7'').

Regarding claim 12, WO 728 discloses the upper support surface of the ski is longitudinally arranged in an area corresponding to a metatarsophalangeal bending zone of a user's foot (fig 6, elements 7' and 7'').

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Regarding claim 13, WO 728 discloses a binding device adapted to be fixed on the ski in the location for receiving the binding device (fig 6, element 42' and 42").

Regarding claim 14, WO 728 discloses the binding device has, at least in the area of the support surface, a lesser width than a width of the ski (fig 6, element 42' and 42").

Regarding claim 16, WO 728 discloses the ski has, at least in part of the central zone, an upper surface, the transverse width of said upper surface being greater than a width of the lower gliding surface of the ski (WO, fig 6, elements 3, 5', 5", and 42' and 42").

Fig 7, clearly shows three distinct regions, the width of raised portion 3 has a transverse width e.g. depth which is greater than the transverse width of the glide surface.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/49728 in view of Haughlin (US Patent No.5, 664,797).

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Regarding claim 15, WO discloses the binding device is adapted to be fitted within the recess of the upper surface of the ski (WO, fig 6), the binding device including no base plate to be mounted upon the ski, so that a lower external surface of the boot is adapted to be directly supported on the upper support surface of the ski (WO 728, fig 6, element 5' and 7'). WO 728 is silent as to the specifics of the binding device, but states that it is known to substitute ski bindings and ski boots to a more safe binding (pg 3, ln 22-24,pg 4, ln 5.pg 7 2<sup>nd</sup> full paragraph). Haughlin discloses the binding device having a rib adapted to be positioned within a downwardly facing longitudinal recess in a sole of the boot (fig 15, element 66). It would have been obvious to one of ordinary skill in the art to use bindings with the ski of WO 728 having ribs adapted to position in grooves like that taught by Haughlin (col 8, lns 10-15). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claim 17, the combination of WO 728 and Haughlin discloses the binding device includes a front jaw adapted to engage a front bar of the boot for enabling articulation of the boot with respect to the ski (Haughlin,fig 15,element 49), the binding device includes an elastic return mechanism, said elastic return mechanism being rearwardly spaced from the front jaw and being adapted to engage a rear bar of the boot for applying an elastic return force to the rear bar (Haughlin,fig 15,element 48) also (Haughlin,col 8,lines 1-23).

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Regarding claim 18, the modified WO 728 ski and binding discloses the binding device is adapted to be affixed to the ski by being positioned within the recess of the upper surface of the ski (WO 728, fig 6, element 5'), the binding device has a rib adapted to be positioned within a downwardly facing longitudinal recess in a sole of the boot (Haughlin, fig 15, element 66), the binding device includes no base plate that would prevent a lower external surface of the boot from direct supporting engagement on the upper support surface of the ski (WO 728, fig 6, elements 7' and 7'').

Regarding claim 19, WO 728 discloses a boot having a support surface adapted to be supported directly by said upper support surface of the ski (fig 6, element 42').

Regarding claim 20, WO 728 discloses a support surface of the boot is a metatarsophalangeal bending zone of the boot (fig 6, element 7' and 7''). Haughlin also shows boot 12 and discusses toe joints in col 10, lines 50-53.

Regarding claims 16 and 21, Haughlin teaches embodiments fig 1-4 where the binding has 2 lateral supporting surfaces 64 that project beyond the upper surface 46 of the ski body 32 to enable precise guidance of the ski and maximal force transmission to the ski body 32, particular during skating (col 8, lines 1-10). It would have been obvious to one of ordinary skill in the art to modify the alpine ski of WO 728 to have a transverse width that is greater than the gliding surface width as taught by Haughlin for the reason set forth therein. While Haughlin teaches the binding having the increase width it would have been obvious to increase the width of the ski of WO 728 since the binding is

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embedded in the ski and therefore the result would be the same whether the ski was able to accommodate the binding or widened to allow precise guidance when skating.

Regarding claim 22, the combination of WO 278 and Haughlin discloses the binding device includes no base plate that would prevent a lower external surface of the boot from direct supporting engagement on the upper support surfaces of the ski (WO 278, fig 6, element 5').

Regarding claim 23, the combination of WO 278 and Haughlin discloses the binding device includes a front jaw (Haughlin, fig 15, element 48, 49) adapted to engage a front bar of the boot for enabling articulation of the boot with respect to the ski the binding device includes an elastic return mechanism (Haughlin, fig 15, elements 48, 49), the elastic return mechanism being rearwardly spaced from the front jaw and being adapted to engage a rear bar of the boot for applying an elastic return force to the rear bar.

Regarding claim 24, the combination of WO 278 and Haughlin discloses a boot having support surfaces adapted to be supported directly by the upper support surfaces of the ski (WO 278, fig 6, elements 5' and 5''), the boot having the front and rear bars (Haughlin, fig 5).

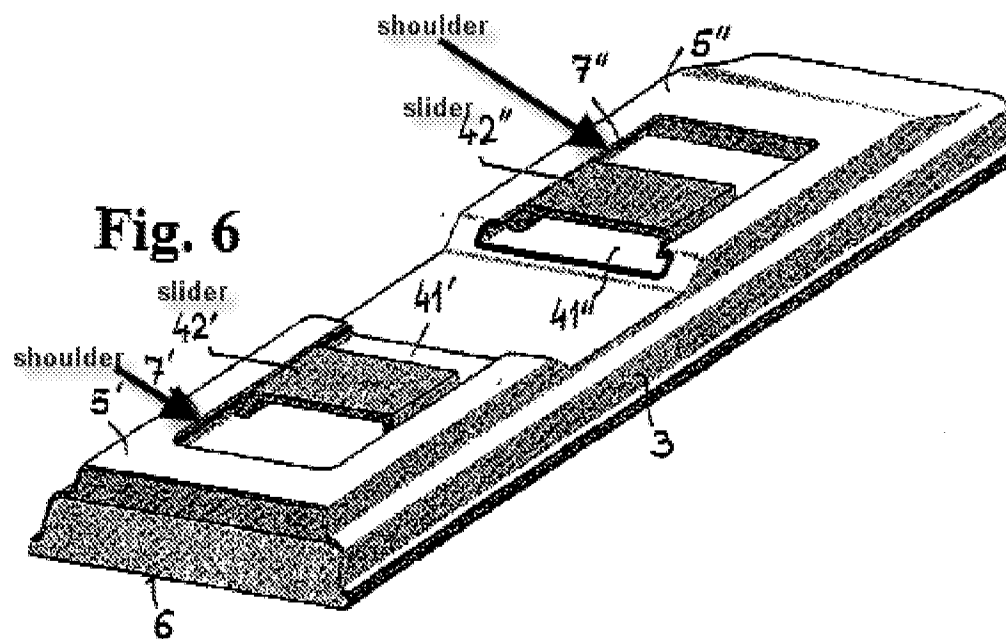
### ***Response to Arguments***

Applicant's arguments filed January 23, 2009 have been fully considered but they are not persuasive.



Applicant argues that WO '728 is for an alpine ski not a cross-country skill. In response to applicant's arguments, the claims are drawn to the structure of a ski and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. The preamble "cross-country" recites no essential structure to give life and meaning to the claim and persons of ordinary skill in the art at the time the invention was made would immediately envision the universal applicability of skis of WO '728 to both alpine and cross-country or touring (page 7, lines 21-25).

Applicant argues that WO'728 is incompatible with "when a skier using the cross country ski system exerts pressure force". The examiner maintains the WO '728 anticipates the structure claimed by applicant (e.g, ski with central zone, binding zone with location for receiving a binding, upper support surface located on at least one of two lateral sides of the location, and the location having an upwardly facing recess of the upper surface of the ski). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. The examiner maintains that the ski of WO '728 that the upper support surface is capable of coming in direct contact with the boot since the structure shown in WO '728 is identical to that claimed and therefore must necessarily be capable of performing the same function and that of applicant since there is no structure currently claimed to positively distinguish the structure of WO '728 from applicant's invention shown best in Figure 3.



Furthermore, applicant argues that elements 7' and 7'' are not shoulders.

Examiner disagrees with applicant, page 11, lines 9-16 states the following:

This embodiment is furthermore characterized by a passage 8 which is arranged in the longitudinal direction of the ski in the central area 3 between the said cutouts 7', 7" in order to receive a not-shown connecting means in order to ensure connection between both sliders 42', 42" as required for establishing appropriate correlation and connection between the forward part and rearward part of the ski binding. In this case, the said passage 8 is available in form of a tunnel or a longitudinal opening available within the ski, but in common it might also be realized e.g. as a groove or a channel arranged on the top surface of the ski.

The examiner maintains that the cutouts 7', 7" necessarily have shoulders as annotated by examiner above.

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Applicant argues that 42' and 42'' are not binding devices, however WO '728 teaches 41', 41'', 42', 42'' as the position attachment assembly for the ski bindings and therefore are broadly understood to cover the various claim language (e.g. claim 8, "a device for binding a boot to the ski", claim 9, "the binding device such that the boot can be supported directly on the shoulder" and claim 13, "a binding device adapted to be fixed on the ski in the location for receiving the binding device". There is nothing in the claims requiring the binding device to be "the bindings" and not a component of the binding mechanism that allows bindings to be fastened to the skis. Binding is broadly understood to include anything that binds or fastens. Therefore, guides 42' and 42'' are an integral part of the positioning assembly for the ski bindings (page 10, lines 13-17) and therefore are considered a binding device.

Regarding claims 15-24, applicant argues the combination of WO'728 in view of Haughlin was improper furthermore applicant argues that the Haughlin device includes a base plate. Examiner disagrees, there is no requirement that a motivation to make the modification b' expressly articulated the test for combining the WO'728 and Haughlin references is what the combination of disclosures taken ad a whole would suggest to one of ordinary skill in the art. The Haughlin reference is being used solely to teach ribs (66) projecting from a binding device on cross country skis for correspondence with grooves on a boot (col. 8, line 59-65). Haughlin is not being relied upon for the base plate. WO '728 teaches the other elements of the claims and repeatedly discusses the applicability of any appropriate ski binding for use with the inventive ski of WO '728.

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See specifically page 3, lines 22-24 set forth below regarding safer more modern ski bindings which is a natural progression in the skiing industry.

It is furthermore a fact that most of people uses skis for several ski-seasons and very often also for various purposes, as well as that people very often sell the skis or exchange them with anybody or resign them to anybody, so that the skis may commonly be assumed as a product like e.g. a car, by which the owner may be changed. On the other hand, the users often decide to substitute the ski binding, either due to increasing his own weight and exceeding the allowed weight, or also due to choice a modern and more safety ski binding.

Regarding the combination of WO '728 and Haughlin, while the examiner admits that alpine bindings and cross-country bindings are markedly different, she maintains that a person of ordinary skill in the art would understand that the WO '728 ski could be manufactured for cross-country use and as such a person of ordinary skill would have known to use corresponding known cross-country or touring bindings which would be attached at only the toe with a releasable the heel which has a groove going into corresponding ribs. As modified the boot of the wearer would necessarily contact the top surface of the ski when pressure is applied since only a portion of the binding contacts the boot and the remainder of the boot is supported by the ski.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CYNTHIA F. COLLADO whose telephone number is (571)272-8315. The examiner can normally be reached on mon-fri 6-2.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. F. C./

Examiner, Art Unit 3781

/Darnell M Jayne/

for Anthony Stashick, SPE TC 3781